

## **REMARKS**

Claims 1-20 are pending. Reconsideration of the present application is respectfully requested in light of the amendments of the claims and the following remarks.

Figures 1-3 of the drawings are objected to as missing legend "Prior Art". Applicants submit herewith replacement sheets of Figures 1-3 including the legend.

Claims 1-20 are objected to for informalities. Applicants have amended claims 1 and 10 to correct the informalities.

Applicant would like to thank the Examiner for indicating that claims 11-20 contain allowable subject matter and would be allowable if rewritten in an independent form including all of the limitations of the base claim and any intervening claims. However, since the Applicant believes that all of the claims are allowable over the cited prior art based upon the following analysis, Applicant respectfully requests the Examiner to reconsider the present application in light of the present response.

The Examiner has rejected claims 1-2 and 4-10 under 35 U.S.C. §102(e) as allegedly anticipated by U. S. Patent No. 6,747,465 to Esashi et al. (hereafter "Esashi"). Applicants respectfully submit that the rejection is overcome in light of the remarks made herein.

To maintain a claim rejection under 35 U.S.C. §102, a reference must disclose each and every element of the claim. Esashi fails to do so.

Applicants' independent claim 1 recites an inspection probe for inspecting electrical properties of a semiconductor device. The probe comprises a base member, wiring layers mounted on the base member, and probe pins electrically connected to the wiring layers and protruding from the base member. The probe further comprises first metal layers provided to the tips of the probe pins, and second metal layers formed on the wiring layers. Significantly, the

first metal layers and the second metal layers are separated from each other.

Turning to the prior art, Esashi discloses a contactor (10) used for testing electrical characteristics of an object to be tested, as shown in Figs. 1 and 2 of Esashi. The contactor comprises a board (11), a plurality of conductive member (12) made of conductive metal, a plurality of beam members (13) and a contact terminal (14) provided at tips of the beam members. The conductive members (12) are buried in through holes formed vertically through the contactor board (see Col. 5, Lines 8-10 of Esashi). Further, the beam members have a step-shaped structure including a step portion (13C) and a coupling portion (13D), disposed between a base end (13B) and a tip (13E) (see Col. 5, Lines 14-21). The contact terminal is formed on tip (13E).

In contrast, claim 1 recites that the wiring layers are mounted on the base member. Since Esashi discloses that the conductive member (12), asserted by the Examiner a disclosure of the wiring layer, is formed through the contactor board, with the upper and lower surfaces of the conductive members flush with the upper and lower surfaces of the contactor board, as clearly shown in Fig. 2 of Esashi, Esashi does not disclose wiring layers mounted on the base member, as recited by claim 1.

In addition, claim 1 recites first metal layers provided to the tips of the probe pins, and second metal layers formed on the wiring layers, wherein the first metal layers and the second metal layers are separated from each other. The Examiner has alleged that the contact terminal (14) of Esashi is a disclosure of first metal layers. The Examiner has further alleged that the step portion (13C) of the beam member is a disclosure of second metal layers, formed on conductive member (12), and that the contact terminal and the step portion are separated from each other.

Applicants respectfully disagree. As illustrated in Figs. 1 and 2 of Esashi, the contact

terminal (14) is connected to the beam member (13), to provide a cantilever type probe (see Col. 5, Lines 34-35 of Esashi). Thus, the contact terminal (14) is not separated from the beam member (13) including the step portion (13C). In fact, the Examiner has isolated the step portion (13C) from the beam member as an independent element to allege that the step portion (13C) is separated from the contact terminal. Further, the Examiner has interpreted the step portion (13C) as an integral part of the beam member to prove that the step portion is formed on the conductive member. Therefore, Esashi does not disclose the first metal layers and the second metal layers are separated from each other.

In view of the foregoing analysis, Esashi fails to disclose each and every element of claim 1, from which all the other claims depend ultimately. Accordingly, the rejection of claims 1-2 and 4-10 under 35 U.S.C. § 102(c) based on Esashi is overcome and withdrawal thereof is respectfully requested.

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as allegedly unpatentable over Esashi. Applicants respectfully submit the rejection is overcome in light of the following remarks.

Claim 1, from which claim 3 depend, is discussed above. Esashi is discussed above relative to claim 1. Since Esashi fails to disclose each and every element of claim 1, Esashi does not teach or suggest the combination of features of claim 3 depending from claim 1. Thus, the rejection of claim 3 under 35 U.S.C. § 103(a) based on Esashi is overcome and withdrawal thereof is respectfully requested.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

If the Examiner should have any questions concerning this communication or feels that an

interview would be helpful, the Examiner is invited to call Applicants' undersigned attorney at the number indicated below.

Respectfully submitted,



Paul J. Esatto, Jr.

Registration No.: 30,749

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343

PJE/HC:me  
Encl.